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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Timothy W. CONNER *et al.*

Appln. No.: 09/333,534

Filed: June 14, 1999

Title: Nucleic Acid Molecules and Other Molecules Associated with Plants

Art Unit: 1631

Examiner: Ardin H. Marschel

Atty. Dkt. No.: 16517.323

Appal No.: 2003-1072

Request for Suspension of Appeal

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

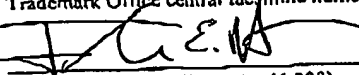
Appellant hereby requests that the Board of Patent Appeals and Interferences ("Board") suspend action in the above-captioned appeal. The issues presented in the appeal involve the utility of partial nucleic acid molecules, such as Expressed Sequence Tags (ESTs), under 35 U.S.C. §§ 101 and 112 and the sufficiency of the written description of these sequences. An appeal involving the utility of partial nucleic acid molecules is currently pending before the United States Court of Appeals for the Federal Circuit ("Federal Circuit"). The sufficiency of the written description has been decided by the Board under similar circumstances as the present appeal.¹

On March 1, 2002 Appellant filed a Notice of Appeal in the above-captioned matter. Thereafter, Appellant filed an Appeal Brief with the Patent Office on May 1, 2002 and waived oral hearing on July 22, 2004.

On May 27, 2004, the Real Party in Interest in the above-captioned matter filed an appeal to the Federal Circuit in *In re Fisher* (U.S. Appln No. 09/619,643, B.P.A.I. Appeal

¹ Rejections for the lack of sufficiency of the written description, have repeatedly been reversed by the Board in similar cases. See, Appeal Nos. 2003-1137, 2003-0996, 2003-1504, 2003-1746 and 2002-2046.

I hereby certify that the foregoing Request for Suspension of Appeal is being facsimile transmitted to the attention of the Board of Patent Appeals and Interferences, via facsimile number (703) 308-6200, and to the U.S. Patent and Trademark Office central facsimile number (703) 872-9306.


Thomas E. Holsten (Reg. No. 46,098)

August 20, 2004
Date

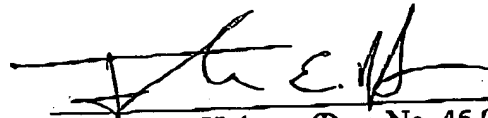
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No. 2002-2046) presenting the issue of the utility of partial nucleic acid molecules, such as ESTs under 35 U.S.C. §§ 101 and 112.²

The Office has stated that postponing consideration of an appeal until the Board has the benefit of a Federal Circuit decision, which may be determinative of an issue in the appeal, is sound practice. *See e.g.* M.P.E.P. §1213, 8th Edition, Revision No. 2, at page 1200-31.

For these reasons, Appellant hereby requests that the Board suspend consideration of the present appeal until the Federal Circuit provides guidance on the issue of the utility of partial nucleic acid molecules, such as ESTs. Should the Commissioner require additional information, he is invited to contact the undersigned at the number provided below.

Respectfully submitted,



Thomas E. Holsten (Reg. No. 46,098)
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Date: August 20, 2004

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² The Board has upheld Examiners' utility rejections in similar appeals. *See, e.g.* Appeal Nos. 2003-1137, 2003-0996, 2003-1504, 2003-1746 and 2002-2046.